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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/270,710	03/16/1999	LAWRENCE F. GLASER	0388-0020	2842

7590

01/26/2004

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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/270,710	Applicant(s) GLASER, LAWRENCE F.	
	Examiner Alexander Kalinowski	Art Unit 3626	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Interview Summary	Application No.	Applicant(s)	
	09/270,710	GLASER, LAWRENCE F.	
	Examiner	Art Unit	
	Alexander Kalinowski	3626	

All participants (applicant, applicant's representative, PTO personnel):

(1) Alexander Kalinowski. (3) _____.

(2) Jerry Massie. (4) _____.

Date of Interview: 11/29/2003.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____.

Claim(s) discussed: 1-19.

Identification of prior art discussed: Bezos.

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant contacted the Examiner and pointed out an error in the citation of prior art with respect to the rejection of claims 1-19. Applicant requested that a corrected office action be sent out and the period of reply reset to mailing date of the corrected office action.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiner's Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

DETAILED ACTION

1. Claims 1-22 are presented for examination. Applicant filed an amendment on 8/22/2001 amending claim 1 and adding claim 22. Applicant further filed a request for continued examination on 3/13/2002. Applicant also filed an amendment on 3/13/2002, amending claims 1-3, 10, 16, 20, and 21. Applicant further filed arguments on 8/28/2002. Applicant further filed a request for continued examination on 9/25/2003 with a preliminary amendment amending claims 1-3, 5-7, 9-10, and 14-22.

Response to Arguments

2. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Remarks

3. Applicant contacted the Examiner and noted that the references cited in the heading of the rejection and the references cited in the body of the rejection of claims 1-19 were different in the office action mailed on 12/04/2003. This action corrects the error in the citation of prior art and since Applicant contacted the Examiner within one month of the mailing date of the office action, the period of response will be reset.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos et al., Pat. No. 6,029,141 (hereinafter Bezos).

As per claim 1, Goldschmitt discloses a method of transmitting an advertisement from a sending party to a receiving party (see abstract and Fig. 4) comprising the steps of:

initiating a communication from a data processing system of a the sending party (see Fig. 1 and page 8, line 26 - page 9, line 2);

transmitting said communication with said at least one advertisement therein to the recipient (see abstract)

Goldschmitt does not explicitly disclose

embedding the advertisement within the communication.

associating the preselected advertisement with said communication within the user-managed data processing system.

However, Bezos discloses embedding the advertisement within the communication and associating the preselected advertisement with said communication within the user-managed data processing system (i.e. can disseminate catalogs ... e-mail newsletters ... that include the associate's reviews and/or recommendations on specific products sold by the merchant)(col. 1, lines 56-61 and col. 8, line 59 – col. 9, line 8). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include embedding the advertisement within the communication and associating the preselected advertisement with said communication within the user-managed

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data processing system as disclosed by Bezos within Goldschmitt for the motivation of efficiently marketing and selling goods (col. 1, lines 50-55).

As per claim 2, Goldschmitt discloses the method of claim 1, further comprising the steps of: offering to the sender an option of becoming an advertiser (i.e. offer to provide free email service) and enabling, if the offer is accepted, a procedure within said user managed data processing system by which said preselected advertisement is associated with the communication (see abstract).

As per claim 3, Goldschmitt discloses the method of claim 1, wherein the advertisement is associated with at least one of software or hardware operable with the user managed data processing system (i.e. email message or software)(see abstract).

As per claim 4, Goldschmitt discloses the method of claim 1, wherein the communication is at least one of e-mail, facsimile, voice-over-IP, voice-over-Internet, voice mail, video mail, video conferencing, and an animated presentation (i.e. email)(see abstract).

As per claim 5, Goldschmitt discloses the method of claim 1, wherein the advertisement is sent for a preselected time period (i.e. between 5:00 PM and 7:00 PM)(page 6, lines 1-11.

As per claim 6, Goldschmitt discloses the method of claim 1, wherein the advertisement is sent up to a pre-selected number of times)(i.e. certain number of times during the day)(page 6, lines 1-11).

As per claim 7, Goldschmitt discloses the method of claim 1, wherein said preselected advertisement is electronically obtained from a third party data processing system (i.e. advertiser storage data files unit 24)(see Fig. 1 and page 8, lines 14-15).

As per claim 8, Goldschmitt discloses the method of claim 2, wherein the user is compensated for accepting the offer to become an advertiser (i.e. user receives free email)(see abstract).

As per claim 9, Goldschmitt discloses the method of claim 1, wherein the advertisement is at least one of visual and aural (i.e. graphics)(page 9, lines 23-29).

As per claim 10, Goldschmitt does not explicitly disclose the method of claim 2, wherein the advertisement is incorporated in setup software for one of software and hardware on said user managed data processing system.

However, the Examiner takes official notice that it was well known to provide advertisements within setup software for software or hardware in the

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computer arts. The purpose was to alert the customer of other products owned by the manufacturer that might be of interest to the customer. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 2, wherein the advertisement is incorporated in setup software for one of software and hardware within the Goldschmitt system for the motivation stated above.

As per claim 11, Goldschmitt discloses the method of claim 2, wherein means for sending the communication comprises at least one of an e-mail client, a facsimile system, a voice-over-IP system, a voice-over-Internet system, a voice mail system, a video mail client, and a video teleconferencing system (i.e. email)(see abstract).

As per claim 12, Goldschmitt discloses the method of claim 2, further comprising offering to a recipient of the communication and advertisement an option of being an advertiser (see abstract).

As per claim 13, Goldschmitt discloses the method of claim 12, wherein said step of offering to a recipient of the communication and advertisement an option of being an advertiser includes fraud avoidance means for reducing or eliminating fraud associated with the transaction (see abstract).

As per claim 14, Goldschmitt discloses the method of claim 7, wherein said preselected advertisement is electronically obtained from a third party data processing system using the Internet (page 8, lines 5-8).

As per claim 15, Goldschmitt discloses the method of claim 1, wherein the advertisement is displayed to a recipient during a period of at least one of before, during and after the communication (page 8, lines 10-13 and page 9, lines 1-7).

As per claim 16, Goldschmitt discloses the method of claim 1, wherein the user managed data processing system is at least one of a computer and telephone (see Fig. 1 and col. 8, lines 1-13).

As per claim 17, Goldschmitt discloses the method of claim 2, wherein the advertisement is embedded in the communication by a third party (i.e. email messaging center 18)(page 8, lines 14-25).

As per claim 18, Goldschmitt discloses the method of claim 1 wherein said preselected advertisement is determined at least in part by the recipient's demographic (i.e. profile match information identifying certain demographic information)(page 8, lines 14-25).

As per claim 19, Goldschmitt discloses the method of claim 18 wherein said demographic is at least one of location, language, gender, age, income, and

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physical handicap (i.e. profile match information identifying certain demographic information)(page 8, lines 14-25).

6. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt in view of Bezos and Uomini, Pat. No. 6,018,761.

As per claim 20, Goldschmitt discloses a method of transmitting an electronic communication including an advertisement from a user managed data processing system associated with a sending party to a data processing system associated with a receiving party (see abstract) comprising the steps of:

transmitting an electronic communication using the data processing system associated with the sending party to the data processing system associated with the recipient (see abstract).

Goldschmitt does not explicitly disclose

embedding the advertisement within the communication.

associating the preselected advertisement with said communication within the user-managed data processing system.

However, Bezos discloses embedding the advertisement within the communication and associating the preselected advertisement with said communication within the user-managed data processing system (i.e. can disseminate catalogs ... e-mail newsletters ... that include the associate's reviews and/or recommendations on specific products sold by the merchant)(col. 1, lines 56-61 and col. 8, line 59 – col. 9, line 8). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include

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embedding the advertisement within the communication and associating the preselected advertisement with said communication within the user-managed data processing system as disclosed by Bezos within Goldschmitt for the motivation of efficiently marketing and selling goods (col. 1, lines 50-55).

Goldschmitt and Bezos do not explicitly disclose

locating a data file containing signature information on the data processing system associated with the sending party, said signature information being appended to electronic communications originating from the user managed data processing system associated with the sending party;

modifying information stored within said signature file to include an advertisement; and

said electronic communication including said information stored within said signature file including said advertisement.

However, Uomini discloses an electronic messaging system that attaches information to the mail messages (see abstract and col. 1, lines 8-10). A signature block (i.e. context data) is used to transmit information to the recipient and is attached to the sender's message (see col. 5, lines 6-18). Furthermore, Uomini discloses the signature block may contain business information (i.e. advertisement)(col. 5, lines 10-12). The motivation for including an advertisement within the signature block was to attach information to the mail message (col. 1, lines 8-10 and col. 3, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include locating a data file containing signature information on the data processing system associated with

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the sending party, said signature information being appended to electronic communications originating from the data processing system associated with the sending party, modifying information stored within said signature file to include an advertisement and said electronic communication including said information stored within said signature file including said advertisement as disclosed by Uomini within the Goldschmitt and Bezos system for the motivation stated above.

As per claim 21, Goldschmitt, Bezos, Uomini do not explicitly disclose the method of claim 20 wherein said signature file is associated with an e-mail client operating on said user managed data processing system associated with the sending party.

The Examiner takes official notice that it was well known in the computer arts to use signature files within user managed data processing systems. The motivation for embedding the advertisements with in a signature file at the third party data processing system allows the system to add advertisements to the portion of the email message that is always present thereby simplifying the efficiency and cost of the system. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 20 wherein said signature file is associated with an e-mail client operating on said data processing system associated with the sending party within the Goldschmitt system for the motivation stated above.

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7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt and Bezos as applied to claim 1 above, and further in view of Uomini.

As per claim 22, Goldschmitt and Bezos do not explicitly disclose the method of claim 1 where associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement.

However, Uomini discloses associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement (see Fig. 2b and 2c). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 1 where associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement within the Goldschmitt and Bezos combination for the motivation of obtaining message context information for the recipient regardless of whether it is provided or not by the sender (col. 1, lines 8-10 and col. 2, lines 56-67).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

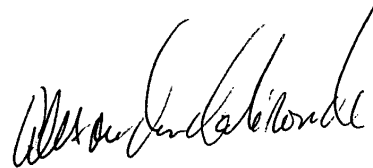
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- a. Pat. No. 6,525,747 discloses a system for conducting an electronic discussion regarding an item.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Primary Examiner

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1/16/04